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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,046	06/22/2001	Nadine Smolarski-Koff	5102.452US01	6967
23552 7590 02/05/2007 MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			EXAMINER BARQADLE, YASIN M	
			ART UNIT	PAPER NUMBER
			2153	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/05/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/888,046

Applicant(s)

SMOLARSKI-KOFF ET AL.

Examiner

Yasin M. Barqadle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11/17/2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-35,42-46 and 48-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35,42-46 and 48-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **Response to Amendment**

Applicant's arguments filed on November 17, 2006 have been considered but are moot in view of the new ground(s) of rejection.

- Claims 1-35,42-46 and 48-52 are pending.
- Claims 1-35,42-46 and 48-52 are presented for examination.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13,16-35,42-46 and 48-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu et al. (U.S. Patent Number 6760752, hereinafter "Liu") in view of Thorne et al (U.S. Patent Number 5958005, hereinafter "Thorne") further in view of Killcommons USPN (7028182).

Claim 1, Liu shows substantial features of the claimed invention including:

Selecting at least one file to be included in said data message (The step of attaching the signed document can include designating a recipient's E-mail address and the sender's E-mail address, designating one or more of a public title and public message body for the E-mail message and attaching the encrypted signed message as an attachment to the E-mail message addressed to the recipient. (Liu, col. 1, lines 58-65 and col. 2, lines 46-51),

determining exchange rights for said recipient, said exchange rights establishing

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actions available to said recipient with respect to handling of said at least one file after said at least one file after said at least one file has been received by said recipient (The recipient receives the wrapper, including encrypted and signed data, through a conventional E-mail service (40). The recipient invokes viewer 130 which in turns performs a series of operations to process and display the secure E-mail message, including attached files if any. The process includes decrypting the encrypted signed data, verifying the sender's signature, verifying the time stamp certificate, verifying the authenticity of the server's public key and retrieving the status of the sender's public key (using the key ID) (42).” (Col. 15, lines 32-41. See also col. 12, lines 19-37),

bundling said at least one file and said exchange rights to form said data message (A secure E-mail composing and wrapping application (hereinafter, "wrapping application) 128 can be invoked to wrap a secure E-mail and apply a signature that can be verified by a recipient. Wrapping application 128 includes a signing process 150 and encryption process 154. Signing process 150 receives as an input a user signature phrase which is used to decrypt the user's private keys (Liu, col. 1, lines 58-65; col. 12, lines 19-37)

Although Liu shows substantial features of the claimed invention, Liu does not show where actions available to a recipient comprise one of archiving and forwarding. Nonetheless this feature is well known in the art and would have been an obvious use of the system disclosed by Liu as evidenced by Thorne USPN (5958005).

In analogous art, Thorne discloses a method for managing the security of electronic documents stored in an interactive information handling system, and more particularly relates to the controlling of the confidentiality of electronic mail communications over networks (col. 1, lines 4-8). Thorne shows “The methodology comprises the procedure of creating in the originating computer a data message having a header which specifies, in addition to the address of the intended recipient computer, one or more security parameters which control the processing of the data message in the recipient computer. The security parameters include instructions for erasure of the data message following its

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storage in the recipient computer. The security parameters also include instructions as to whether or not copying, archiving, forwarding and printing of the data message is permitted" (Thorne, Abstract, col. 6, lines 31-61). Given these teachings, a person of ordinary skill in the art would have readily recognized the desirability and advantages of implementing the system of Liu and Thorne so protect the confidentiality of electronic mail communications and to control the usage of the documents by the recipient for further dissemination and storage. Additionally, to provide to an E-Mail originator or sender the capability to control the ability of the recipient to copy, forward, print, and store received files.

Although Liu in view of Thorne show substantial features of the claimed invention, Liu in view of Thorne do not show where the file is a medical image file. Nonetheless this feature is well known in the art and would have been an obvious use of the system disclosed by Liu and Thorne as evidenced by Killcommons USPN (7028182).

In analogous art, Killcommons discloses a network system for secure communication of medical information across a virtual private network. The medical information may take numerous forms, including text, images and video and, or variations thereof (col. 1, lines 63-66 and col. 6, lines 62-67). Given these teachings, a person of ordinary skill in the art would have readily recognized the desirability and advantages of modifying the system of Liu and of Thorne so as to transfer confidential medical records over a public network in a secure and efficient manner.

Claim 2, Killcommons shows wherein said selecting further includes selecting at least one annotation, audio and/or text file related to said at least one medical image file (Killcommons col. 6, lines 62-65)

Claims 3, Killcommons shows an exam record stored in a database, said exam record being opened to expose the files therein through user interface to enable files in said exam record to be selected (Killcommons col. 6, lines 62 to col. 7, line 22 and col. 3,

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lines 48-54)

Claims 4, Killcommons teaches a graphical user interface for selecting files of the exam record using a computer pointing device (Killcommons col. 6, lines 22-31)

Claims 5, Liu teaches wherein during determining exchange rights of said recipient, different categories of exchange rights are examined to locate the category to which said recipient has been assigned thereby to determine the exchange rights for said recipient (Liu Col. 15, lines 32-41)

Claims 6, Thorne teaches wherein during examination of the different categories of exchange rights if the recipient is not located, default exchange right are assigned to said recipient (Thorne, col. 7, lines 1-5).

Claim 7, Thorne in view of Liu teach wherein different categories of exchange rights include browse only, browse and archive, browse and forward, and browse, archive and forward exchange rights (Thorne, Abstract, col. 6, lines 31-61)

Claim 8, Liu shows, the step of encrypting clear text in a selected related text file prior to said bundling.

*“encrypting the signed message using a public key encryption algorithm and the public key of the recipient producing an encrypted signed message”* (Liu, col. 1, lines 59-62)

Claim 9, Liu shows, the step of encoding selected audio and/or text files prior to said bundling. *“The step of generating an E-mail message can include creating a MIME E-mail message addressed to the recipient. The step of attaching the signed document can include attaching the signed document to the MIME mail message as a MIME attachment. The step of transmitting can include sending the MIME mail message to the recipient.”* (Liu, col. 3, lines 6-11)

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Claim 10, Liu shows, said encoding includes at least one of compressing and scrambling said audio and/or text files:

*Liu, col. 1, lines 59-62* (see full quote above), encrypting is a method of scrambling

Claim 11, Liu shows, the step of encrypting said data message after said bundling:

*Liu, col. 1, lines 59-62* (see full quote above)

Claim 12, Liu shows, the step of MIME encoding said encrypted data message:

*Liu, col. 3, lines 6-11* (see full quote above)

Claim 13, Liu shows, said at least one image file is compressed:

*Liu, col. 16, lines 13-16* (see full quote above)

Claim 16, Liu in view of Throne and further in view of Killcommons show substantial features of the claimed invention as explained in claim 1 above.

Liu further shows deconstructing said data message at said recipient (Liu, col. 12, lines 31-40 and Liu fig. 4),

Claim 17, Thorne in view of Liu teach wherein different categories of exchange rights include browse only, browse and archive, browse and forward, and browse, archive and forward exchange rights (Thorne, Abstract, col. 6, lines 31-61)

Claim 18, Liu shows, setting a flag following transmission of said data message to said recipient computer system and generating a prompt if a receipt acknowledgement is not received from said recipient computer system within a threshold period of time following said transmission *"The method can include attaching a return receipt request to the E-mail message and acknowledging the return of a receipt including displaying the*

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*receipt to the sender. The opening of the E-mail message by the recipient can be conditioned upon the return of the return receipt.” (Liu, col. 3, lines 1-5)*

Claim 19, Killcommons shows wherein said selecting further includes selecting at least one annotation, audio and/or text file related to said at least one medical image file (Killcommons col. 6, lines 62-65)

Claim 20, Liu shows, during said creating said at least one image file, said at least one related image annotation, audio and/or text file and said exchange rights are bundled to form said data message *Liu, col. 16, lines 13-16* (see full quote above), all the files for one message are bundled

Claim 21, Liu shows, the step of encrypting clear text in each text file in said data message prior to said bundling.

*Liu, col. 1, lines 59-62* (see full quote above); any clear text in the message would be encrypted

Claim 22, Liu shows, the step of encoding each audio and/or text file in said data message prior to said bundling.

*Liu, col. 3, lines 6-11* (see full quote above)

Claim 23, Liu shows, said encoding includes at least one of compressing and scrambling each said audio and/or text file.

*Liu, col. 1, lines 59-62* (see full quote above), encrypting is a method of scrambling

Claim 24, Liu shows, the step of encrypting said data message prior to said transmitting:

*Liu, col. 1, lines 59-62* (see full quote above)



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Claim 25, Liu shows, the step of MIME encoding said encrypted data message prior to said transmitting:

*Liu, col. 3, lines 6-11 (see full quote above)*

Claim 26, Liu shows, during said deconstructing, said data message is MIME decoded, decrypted and de-bundled "*Substantially contemporaneous with sending the message, the method can include prompting the sender for a signature phrase, decrypting the private key of the sender using the signature phrase, applying a hash function to a sender's public key to produce a hash and verifying a status of the sender's public key including submitting the hash to the external key server to enable a look-up of a status of a public key of the sender.*" (Liu, col. 2, lines 14-21), a system that encodes, encrypts and bundles a message at a sender inherently implies decoding, decrypting and de-bundling at the recipient

Claims 27, 44 and 48-51, Liu in view of Throne and further in view of Killcommons show substantial features of the claimed invention as explained in claims 1, 16 and 17. These claims have similar limitations as claims 1,16 and 17. Therefore they are rejected with the same rationale.

Claim 28, Liu shows, the step of setting a flag at said sender computer system following transmission of said data message to said recipient computer system and generating a prompt if a receipt acknowledgement is not received from said recipient computer system within a threshold period of time following said transmission (*Liu, col. 3, lines 1-5 (see full quote above)*)

Claim 29, Killcommons shows wherein said selecting further includes selecting at least one annotation, audio and/or text file related to said at least one medical image file

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(Killcommons col. 6, lines 62-65)

Claim 30, Liu shows, the step of at the recipient computer system, transmitting a reply data message to the sender computer system:

*Liu, col. 3, lines 1-5 (see full quote above)*

Claim 31, Liu shows, said reply data message includes at least one audio and/or text file and said exchange rights:

Exchange rights are included in transmissions between the sender and receiver in both directions

Claim 32, Liu shows, the step of setting a flag at said recipient computer system following transmission of said data message to said sender computer system and generating a prompt if a receipt acknowledgement is not received from said sender computer system within a threshold period of time following said transmission “*A different way of sending a return receipt is for the recipient to retrieve a second time stamp certificate from the server (which certifies the time the message was received) and then send both the TSC of sending time and TSC of receiving time to the sender, with both TSCs being signed and encrypted. More specifically, the return receipt is: PKE(SenderPublicKey, Signed(RecipientKey, TSC(send time)+TSC(receive time)+OtherInfo)), where OtherInfo may contain the public subject or and other purposes.*” (Liu, col. 31, lines 35-43)

Claim 33, Liu shows, the step of encrypting clear text in each text file in said data message and said reply data message prior to said transmitting.

*Liu, col. 1, lines 59-62 (see full quote above)*

Claim 34, Liu shows, the step of encoding each audio and/or text file in said data message and said reply data message prior to said transmitting.

*Liu, col. 3, lines 6-11 (see full quote above)*

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Claim 35, Liu shows, the step of encrypting said data message and said reply data message prior to said transmitting:

*Liu, col. 1, lines 59-62 (see full quote above)*

Claim 43, Thorne in view of Liu teach wherein different categories of exchange rights include browse only, browse and archive, browse and forward, and browse, archive and forward exchange rights (Thorne, Abstract, col. 6, lines 31-61)

Claims 45, Liu teaches wherein during determining exchange rights of said recipient, different categories of exchange rights are examined to locate the category to which said recipient has been assigned thereby to determine the exchange rights for said recipient (Liu Col. 15, lines 32-41)

Claims 46, Thorne teaches wherein during examination of the different categories of exchange rights if the recipient is not located, default exchange right are assigned to said recipient (Thorne, col. 7, lines 1-5).

Claim 52, Thorne teaches the invention, wherein said actions comprise at least forwarding of said at least one medical image file (Thorne, Abstract, col. 6, lines 31-61)

Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu in view of Throne and further in view of Killcommons and further in view of Inoue et al. (*A digital watermark technique based on the wavelet transform and its robustness on image compression and transformation*, SCIS, 1998, hereinafter "Inoue over Liu in view of Throne and further in view of Killcommons show substantial features of the claimed invention, including compressing an image file. However, Liu in view of Throne and further in view of Killcommons do not show a using a wavelet algorithm method of compression. Nonetheless this feature is well known in the art and would have been an obvious modification to the system disclosed by Liu in view of Throne and further in view of Killcommons as evidenced by Inoue.

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In analogous art, Inoue discloses a digital watermark technique based on the wavelet transform and its robustness on image compression and transformation. Inoue shows using the wavelet transformation for compression and watermarking (Inoue, pg. 2, col. 2, paragraph 2)

Given these teachings, a person of ordinary skill in the art would have readily recognized the desirability and advantages of modifying the system of Liu in view of Throne and further in view of Killcommons so as to compress and watermark the image using a wavelet algorithm, in order to be able to extract the watermark if the image is degraded through a common signal and geometric processing procedures.

### Conclusion

**ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

The prior made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yasin Barqadle whose telephone number is 571-272-3947. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Burgess can be reached on 571-272-3949. The fax phone numbers for

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the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR system. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YB

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KRISNA LIM  
PRIMARY EXAMINER